

In the

Supreme Court of the United States

October Term, 1990

FEIST PUBLICATIONS, INC.,

Petitioner,

v.

RURAL TELEPHONE SERVICE COMPANY, INC.,

Respondent.

On Writ of Certiorari to the
United States Court of Appeals
for the Tenth Circuit

**BRIEF OF WEST PUBLISHING COMPANY
AS AMICUS CURIAE IN SUPPORT OF
RESPONDENT RURAL TELEPHONE SERVICE COMPANY**

VANCE K. OPPERMAN

Counsel of Record

OPPERMAN HEINS

& PAQUIN

2200 Washington Square

100 Washington Avenue South

Minneapolis, Minnesota 55401

(612) 339-6900

Of Counsel

JAMES E. SCHATZ

BRADLEY W. ANDERSON

OPPERMAN HEINS

& PAQUIN

2200 Washington Square

100 Washington Avenue South

Minneapolis, Minnesota 55401

(612) 339-6900

*Counsel for West Publishing
Company*

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PRELIMINARY STATEMENT

West Publishing Company ("West") submits this brief as *amicus curiae* pursuant to Rule 37.3 of the Rules of this Court in support of Respondent Rural Telephone Service Company, Inc.¹

INTEREST OF AMICUS CURIAE

West is generally interested in copyright issues relating to compilations, and particularly issues regarding the copyrightability of compilations and scope of protection given to compilations as a whole and to the assembled data contained therein. Many of West's publications, such as its National Reporter System publications, contain significant amounts of public domain materials, including judicial decisions and statutes. West collects and assembles these materials, creates a variety of related editorial enhancements such as synopses, headnotes, key number classifications and annotations and then compiles and publishes such materials and enhancements in convenient and accessible formats. West also compiles and makes available many of these materials and enhancements on WESTLAW, its online computer-assisted legal research service, and, more recently, on its West CD-ROM Libraries compact disc products.

In recent years, West increasingly has been required to seek judicial relief to prevent infringement of its copyrighted compilations. For example, West was forced to act to prevent unauthorized copying by Mead Data Central, Inc. of the copyrighted case report arrangements contained in its National Reporter System publications. *West Publishing Co. v. Mead Data Central, Inc.*, 799 F.2d 1219 (8th Cir. 1986), *cert. denied*, 479 U.S. 1070 (1987). Although West has been successful in protecting its copyrighted compilations, the judicial rulings in West's favor have, on occasion, been misunderstood or mischaracterized by third parties in later litigation, as was done here by the Association of North

¹Consent to file this brief was given by both parties and has been separately filed with the Clerk of Court.

American Directory Publishers and the Directory Publishers Association in their *amicus curiae* brief in support of Petitioner's request for a writ of certiorari ("NADP Cert. Brief"), and by commentators.²

With respect to the present case, West is critically concerned with the attempt by Petitioner and the various

²For example, the assertion by NADP that the decision in *West Publishing Co. v. Mead Data Central, Inc.*, 799 F.2d 1219 (8th Cir. 1986), cert. denied, 479 U.S. 1070 (1987), was based on the purported "sweat of the brow" doctrine simply is not true. See NADP Cert. Brief at 13. The Eighth Circuit did not rely on the "sweat of the brow" doctrine in reaching its decision. Instead, in recognizing the validity of West's copyrights, the Eighth Circuit expressly found that West's case arrangements contained in its National Reporter System publications constituted original works of authorship protected by the Copyright Act:

We conclude, as did the District Court, that the arrangement West produces through this process is the result of considerable labor, talent, and judgment. As discussed above, [citation omitted] to meet the intellectual-creation requirements a work need only be the product of a modicum of intellectual labor; West's case arrangements easily meet this standard. Further, since there is no allegation that West copies its case arrangements from some other source, the requirement of originality poses no obstacle to copyrighting the arrangements.

799 F.2d at 1226-27.

Further, while the Eighth Circuit's decision in *West v. Mead* has been widely discussed by commentators, the decision clearly has not been "the object of near-universal scholarly criticism" as asserted by *amicus* NADP. See NADP Cert. Brief at 13. The decision has been cited and/or discussed by many different commentators in law review articles, treatises and other periodicals, and has been approved of in both result and reasoning by a substantial number of such commentators. See, e.g., Gorman, *Opinion on Legal-Research Services Raises Major Computer-Age Issues*, Nat'l L.J., July 20, 1987, at 40; Davidson, *Common Law, Uncommon Software*, 47 U. Pitt. L. Rev. 1037 (1986); Case Comment, *Copyright Protection for Citations to a Law Reporter: West Publishing Co. v. Mead Data Central, Inc.*, 71 Minn. L. Rev. 991 (1987); Note, *Copyrighting the Book of Numbers—Protecting the Compiler: West Publishing Co. v. Mead Data Central, Inc.*, 20 Creighton L. Rev. 1133 (1987); Comment, *West Publishing Co. v. Mead Data Central, Inc. (LEXIS)*, 14 Rutgers Computer & Tech. L.J. 359 (1988).

For example, Professor Gorman has stated that:

amici curiae supporting Petitioner ("Amici") to alter long-standing, fundamental principles of copyright law upon which West and other publishers have relied in structuring their business operations and creating and distributing their publications.

SUMMARY OF ARGUMENT

Under the current Copyright Act, the copyrightability of a compilation depends upon whether it is an "original work of authorship." 17 U.S.C. § 102(a). In utilizing that terminology, Congress expressly intended to incorporate the standard of originality established under the Copyright Act of 1909 ("1909 Act"). The test of originality, and hence copyrightability, under the 1909 Act did not require that a compilation of data possess some novel or unique element of "selection, coordination or arrangement" in order to be

To a considerable extent, *West* can be viewed as merely applying, in a specific factual context (albeit one of special fascination for lawyers), conventional rules of copyright law regarding originality, infringement and fair use of compilations. It is, however, a case that raises these issues in the context of new computer technologies, which challenge certain basic assumptions about the scope of protection of factual compilations in an age of almost instantaneous absorption, manipulation and restructuring of information.

Although the outcome of the case will no doubt stir debate at the bar (in the courtroom and over across the street), it moves the law in a sound direction.

Gorman, Nat'l L.J., July 20, 1987, at 41.

In addition to commentators, a number of courts have cited the case with approval for a variety of propositions. See, e.g., *Atari Games Corp. v. Oman*, 888 F.2d 878, 882-83 (D.C. Cir. 1989) (standard of originality required for copyrightability); *M. Kramer Mfg. Co. v. Andrews*, 783 F.2d 421, 438 (4th Cir. 1986) (while facts are not copyrightable, their original arrangement in a compilation may be copyrighted); *Lotus Dev. Corp. v. Paperback Software Int'l*, 740 F. Supp. 37, 48 (D. Mass. 1990) (discussing original works of authorship); *Rand McNally & Co. v. Fleet Management Sys.*, 634 F. Supp. 604, 606 (N.D. Ill. 1986) (difference in arrangement in computer database compared to that of printed work does not preclude finding infringement).

protected; nor were such features the only elements of a compilation which were protected by courts under the 1909 Act. In enacting the Copyright Act of 1976 ("1976 Act"),³ Congress did not repudiate or intend to repudiate any of the decisions which set forth the protection accorded compilations under the 1909 Act. To the contrary, the expressed intent of Congress was to adopt and codify the scope of protection accorded compilations under existing case law.

Petitioner's and *Amici's* arguments that the only protectible elements of a compilation of factual material are the "selection, coordination or arrangement" thereof, and that substantial copying of the collection and assemblage of factual material contained in a compilation is permitted as long as the "selection, coordination or arrangement" of the material is not copied, rest upon a serious misreading of the definition of "compilation" contained in the 1976 Act. A proper reading of the definition demonstrates that Congress neither intended to narrow the variety of works traditionally protected as compilations, nor to limit the traditional protection accorded to such "original works of authorship."

ARGUMENT

I. THE DECISION REACHED BELOW IS NOT IN CONFLICT WITH THE DECISION OF ANY OTHER CIRCUIT INVOLVING A DIRECTORY

Despite the assertions by Petitioner and *Amici*, the district court and the Tenth Circuit did not rely on the so-called "sweat of the brow" doctrine of copyright protection in their decisions. Neither court expressed any opinion regarding such doctrine nor stated that its decision was the result of an application of the doctrine.

Instead, the courts below rendered decisions which are in accordance with the result reached by every circuit that has ever been presented with a claim of infringement of a copyrighted directory under either the 1909 or 1976 Act—

³The Copyright Act of 1976, found at Title 17 of the United States Code, was enacted in 1976 and became effective on January 1, 1978.

the collection and assemblage of names, addresses and other data contained in a copyrighted directory cannot be copied or otherwise used as a source to create a competing directory, whatever the precise theory of protection relied upon by a particular court. *Illinois Bell Tel. Co. v. Haines & Co.*, 905 F.2d 1081 (7th Cir. 1990) (telephone directory); *Konor Enterprises, Inc. v. Eagle Publications, Inc.*, 878 F.2d 138 (4th Cir. 1989) (telephone directory); *United Tel. Co. v. Johnson Publishing Co.*, 855 F.2d 604 (8th Cir. 1988) (telephone directory); *Hutchinson Tel. Co. v. Fronterer Directory Co.*, 770 F.2d 128 (8th Cir. 1985) (telephone directory); *Southern Bell Tel. & Tel. Co. v. Associated Tel. Directory Publishers*, 756 F.2d 801 (11th Cir. 1985) (telephone directory); *Adventures in Good Eating, Inc. v. Best Places to Eat, Inc.*, 131 F.2d 809 (7th Cir. 1942) (restaurant directory); *Leon v. Pacific Tel. & Tel. Co.*, 91 F.2d 484 (9th Cir. 1937) (telephone directory); *Jeweler's Circular Publishing Co. v. Keystone Publishing Co.*, 281 F. 83 (2d Cir.), cert. denied, 259 U.S. 581 (1922) (trademark directory).⁴

Quite simply, no court of appeals, when presented with the type of systematic copying from a copyrighted directory present in this case, has ever concluded that such copying was not an infringement. Thus, there is no conflict between the result reached by the Tenth Circuit below and the result reached by every other circuit presented with the same factual circumstance.

In addition, because the Tenth Circuit did not rely upon the "sweat of the brow," or, more appropriately, the "industrious collection" doctrine, there is not even a conflict *in principle*. In fact, the cases which may appear to utilize the supposedly separate rationales of "industrious collection" and "selection and arrangement" do not even conflict in theory when closely analyzed. Previous compilation decisions are best understood not as advocating two separate theories of protection, but rather as emphasizing the different aspects of authorship reflected in

⁴In fact, the clarity of existing precedent on this point is likely the reason the Tenth Circuit elected to dispose of this matter with an unpublished opinion.

compilations. Some cases emphasize the author's "selection or arrangement" of data, while others emphasize the authorship in "collecting and assembling" individual facts to create a compilation of data.

It is also important to recognize that to the extent Petitioner relies upon the asserted "monopoly" status of Respondent as a justification for copying Respondent's directory (Petitioner's Brief at 22-23), that justification must be based on federal antitrust law, and not grounded upon a distortion of federal copyright law. If the antitrust laws require that the names and addresses collected by a telephone service monopoly be licensed at reasonable rates, then that result should be based upon antitrust principles and not obtained through an interpretation of copyright law which would demolish decades of established principles relating to compilations of all types.

II. THE COPYRIGHTABILITY OF COMPILATIONS UNDER THE 1976 ACT DEPENDS UPON THE STANDARD OF ORIGINALITY ESTABLISHED BY THE 1909 ACT

The copyright clause of the Constitution, article I, section 8, clause 8, allows Congress to grant to "Authors" exclusive rights to their "Writings." Through the 1976 Act, Congress has elected to extend copyright protection to "original works of authorship fixed in any tangible medium of expression." 17 U.S.C. § 102(a). The 1976 Act does not define the phrase "original works of authorship," but the House Report did address the issue:

The phrase "original works of authorship," which is purposely left undefined, is intended to incorporate *without change* the standard of originality established by the courts under the present [i.e., the 1909] copyright statute.

H.R. Rep. No. 1476, 94th Cong., 2d Sess. 51 (1976) ("House Report") (emphasis added). Thus, the standard of "originality" as established by the courts under the 1909 Act must be ascertained to determine the meaning of the

phrase "original works of authorship" as used in the 1976 Act.

The "originality" standard established under the 1909 Act, and prior copyright acts, consists of two components. The first component arose from this Court's definition of an "Author" in *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 4 S. Ct. 279 (1884). There, this Court determined that an "Author" under the copyright clause was "he to whom anything owes its origin; originator; maker." *Id.* at 57-58, 4 S. Ct. at 281. As a result, a work was "original" if it "owed its origin" to an author. There was no requirement imposed by this definition that a work possess any novelty, uniqueness or aesthetic merit in order to be original. *Burrow-Giles* required only that a work be independently created by an author. This was the universal construction of the term "original" under the 1909 Act.⁵ In enacting the current Copyright Act, Congress clearly understood and accepted that "[t]his standard [of originality under the 1909 Act] does not include requirements of novelty, ingenuity, or esthetic merit, and there is no intention to enlarge the standard of protection to require them." *House Report* at 51.

The second component of originality under the 1909 Act arose from this Court's determination that the word "Writings" in the copyright clause "include[s] any physical rendering of the fruits of creative intellectual or esthetic labor." *Goldstein v. California*, 412 U.S. 546, 561-62, 93 S. Ct. 2303, 2312 (1973) (citing *Burrow-Giles*, 111 U.S. at 58, 4 S. Ct. at 281; *Trade-Mark Cases*, 100 U.S. 82, 94 (1879)). Thus, it is clear that the 1909 Act also required a work to possess some amount of creative intellectual effort or labor in order to be an "original work of authorship."

However, in *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 23 S. Ct. 298 (1903), this Court made it clear it is

⁵ See, e.g., *Lin-Brook Builders Hardware v. Gertler*, 352 F.2d 298, 301 (9th Cir. 1965); *Wihtol v. Wells*, 231 F.2d 550, 553 (7th Cir. 1956); *Alfred Bell & Co. v. Catalda Fine Arts, Inc.*, 191 F.2d 99, 102-03 (2d Cir. 1951). See also 1 P. Goldstein, *Copyright* § 2.2.1 (1989) ("Goldstein"); 1 M. Nimmer & D. Nimmer, *Nimmer on Copyright* § 2.01[A] (1990) ("Nimmer").

not the role of a judge to weigh the artistic quality or worth of a particular work when ascertaining the presence in that work of the requisite degree of "creative intellectual or aesthetic labor":

It would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations, outside of the narrowest and most obvious limits. At the one extreme, some works of genius would be sure to miss appreciation. Their very novelty would make them repulsive until the public had learned the new language in which their author spoke. . . . At the other end, copyright would be denied to pictures which appealed to a public less educated than the judge. Yet, if they command the interest of any public, they have a commercial value,—it would be bold to say that they have not an aesthetic and educational value,—and the taste of any public is not to be treated with contempt. It is an ultimate fact for the moment, whatever may be our hopes for a change. That these pictures had their worth and their success is sufficiently shown by the desire to reproduce them without regard to the plaintiffs' rights.

Id. at 251-52, 23 S. Ct. at 300.

In determining those "narrowest and most obvious limits" in which works are excluded from copyright for lack of intellectual effort, this Court instructed that:

[A] very modest grade of art has in it something irreducible, which is one man's alone. That something he may copyright unless there is a restriction in the words of the act.

Id. at 250, 23 S. Ct. at 300. As a result of this admonition, courts have required that only a very slight degree of intellectual labor or creativity be present for a work to be considered an original work of authorship and, hence, copyrightable. See, e.g., *Alfred Bell & Co.*, 191 F.2d at 102-03 ("[a]ll that is needed to satisfy both the Constitution and the statute is that the 'author' contributed something more

than a 'merely trivial' variation, something recognizably 'his own'"); *Universal Athletic Sales Co. v. Salkeld*, 511 F.2d 904, 908 (3d Cir.), cert. denied, 423 U.S. 863 (1975); *Drop Dead Co. v. S.C. Johnson & Son, Inc.*, 326 F.2d 87, 92 (9th Cir. 1963), cert. denied, 377 U.S. 907 (1964). See also *Goldstein*, § 2.2.1.2; *Nimmer*, § 2.01[B].

Section 5(a) of the 1909 Act specifically granted copyright protection to "composite and cyclopedic works, directories, gazetteers, and other compilations." Copyright Act of 1909, ch. 391, § 5(a), 61 Stat. 654 (recodified 1947). Section 103(a) of the 1976 Act likewise accords protection for compilations. In applying the 1909 Act (and prior acts), this Court and other courts encountered little difficulty in concluding that original compilations of pure factual material, including directories of names, addresses, businesses and trade suppliers, met both components of the originality standard. See, e.g., *Dun v. Lumbermen's Credit Ass'n*, 209 U.S. 20, 28 S. Ct. 335 (1908) (owner of copyrighted directory of North American merchants, manufacturers and traders permitted to recover whatever monetary damages they actually sustained from defendant's copying of directory); *Bleistein*, 188 U.S. at 250, 23 S. Ct. at 300 ("[t]he least pretentious picture has more originality in it than directories and the like, which may be copyrighted"). See also *Nimmer*, § 3.02 n.9 (collecting cases).

The 1909 Act's recognition of originality in factual works, including compilations, has been carried forward under the 1976 Act. As this Court recently observed, "[c]reation of a nonfiction work, even a compilation of pure fact, entails originality." *Harper & Row, Publishers, Inc., v. Nation Enterprises*, 471 U.S. 539, 547, 105 S. Ct. 2218, 2224 (1985).

III. CONGRESS DID NOT INTEND THE DEFINITION OF COMPILED CONTAINED IN THE 1976 ACT TO ALTER THE PRINCIPLES ESTABLISHED UNDER THE 1909 ACT REGARDING EITHER THE COPYRIGHTABILITY OF OR SCOPE OF PROTECTION ACCORDED TO A COMPILED

In enacting the 1976 Act, Congress did not intend to reject those decisions which had found original authorship in the collection and assemblage of facts created through the efforts of a compiler. The argument that the "industrious collection" doctrine was repudiated by Congress under the 1976 Act is based entirely upon a misreading of the definition of "compilation" found in Section 101 of the 1976 Act, 17 U.S.C. § 101.

A. Copyright Protection Under The 1909 Act Was Not Limited To The Selection, Coordination Or Arrangement Of Factual Data Contained In A Compilation

The 1909 Act contained no definition of the term "compilation," yet, as we have seen, that Act clearly conferred copyright protection upon factual compilations, including telephone directories. The definition of compilation contained in the 1976 Act provides as follows:

A "compilation" is a work formed by the collection and assembling of preexisting materials or of data that are selected, coordinated, or arranged in such a way that the resulting work as a whole constitutes an original work of authorship. The term "compilation" includes collective works.

17 U.S.C. § 101. Reasoning principally from this definition, Petitioner and *Amici* argue that authorship in a compilation may only be found in a compiler's original "selection, coordination or arrangement" of data, and that an alphabetical arrangement of names or a selection of *all* telephone company customers in a city is not an original

work of authorship.⁶ This interpretation of the Section 101 definition was not intended by Congress and is not warranted by the plain language of the definition.

In enacting the 1976 Act, Congress made clear when a compilation is copyrightable:

A compilation or derivative work is copyrightable if it represents an "original work of authorship" and falls within one or more of the categories listed in section 102.

House Report at 57. As earlier demonstrated, Congress did not intend to make *any* change to the meaning of "original work of authorship" from the 1909 Act:

The phrase "original works of authorship," which is purposely left undefined, is intended to incorporate *without change* the standard of originality established by the courts under the present copyright statute.

Id. at 51 (emphasis added). Thus, Congress clearly intended that a compilation would be copyrightable if it was an "original work of authorship," and expressly stated that it was not changing the standard of originality traditionally applied under the 1909 Act.

Under the 1909 Act, it was clear that a directory was copyrightable and protected against substantial copying if the directory was created by the original efforts of the compiler in collecting and assembling the individual facts. Every circuit which considered the issue agreed that a compilation which was the product of substantial effort on the part of a compiler in collecting and assembling the data was copyrightable and that substantial copying of the collection of data in such a compilation was an infringement. *Schroeder v. William Morrow & Co.*, 566 F.2d 3, 5-6 (7th Cir. 1977); *Leon v. Pacific Tel. & Tel. Co.*, 91 F.2d 484, 486 (9th

⁶While Petitioner and *Amici* pay lip service to the well-settled rule that white pages directories are protected by copyright, there would be nothing to protect under their interpretation of Sections 101 and 103 because in their view neither the alphabetical arrangement of a directory nor the comprehensive selection of the names contained within it would constitute protectible matter. See Petitioner's Brief at 18, 22; NADP Brief at 17 n.19.

Cir. 1937); *W.H. Anderson Co. v. Baldwin Law Publishing Co.*, 27 F.2d 82, 90-91 (6th Cir. 1928); *Jeweler's Circular Publishing Co. v. Keystone Publishing Co.*, 281 F. 83, 88-89 (2d Cir.), cert. denied, 259 U.S. 581 (1922).

In addition to according copyright protection based on the authorship inherent in collecting and assembling individual facts to create a compilation, circuits under the 1909 Act also recognized authorship in a compiler's particular selection or arrangement of data. *College Entrance Book Co. v. Amsco Book Co.*, 119 F.2d 874, 875-76 (2d Cir. 1941); *Hartfield v. Peterson*, 91 F.2d 998, 1000 (2d Cir. 1937); *Edwards & Deutsch Lithographing Co. v. Boorman*, 15 F.2d 35, 36 (7th Cir.), cert. denied, 273 U.S. 738 (1926). Thus, under the 1909 Act, a compilation of data was considered copyrightable if the intellectual labor or effort reflected in either the collection and assemblage of data or the selection or arrangement of data, or both, was sufficient to constitute an original work of authorship. This was the unquestioned state of the law at the time Congress enacted the 1976 Act. Congress, when it passed the 1976 Act, did not repudiate the theory of *any* of the judicial decisions according copyright protection to compilations of data, nor did it statutorily reverse or alter the scope of protection such decisions accorded the collection and assemblage of data contained in copyrighted compilations.⁷

⁷Indeed, when Congress disagreed with a particular judicial decision interpreting the 1909 Act, it made its disapproval quite plain in the legislative history of the 1976 Act and clearly indicated that the 1976 Act was intended to alter the result of the decision. See *House Report* at 52 (disagreeing with *White-Smith Music Publishing Co. v. Apollo Co.*, 209 U.S. 1, 28 S. Ct. 319 (1908)); *House Report* at 64 (disagreeing with *Metro-Goldwyn-Meyer Distributing Corp. v. Wyatt*, 21 C.O. Bull. 203 (D. Md. 1932)); *House Report* at 157 (altering *Vacheron & Constantin-Le Coultre Watches, Inc. v. Benrus Watch Co.*, 260 F.2d 637 (2d Cir. 1958)); *House Report* at 86-87 (rejecting the basis of the Supreme Court's decision in *Twentieth Century Music Corp. v. Aiken*, 422 U.S. 151, 95 S. Ct. 2040 (1975), and codifying pre-Aiken interpretations of *Buck v. Jewell-La Salle Realty Co.*, 283 U.S. 191, 51 S. Ct. 410 (1931), as Section 110(5) of the 1976 Act). The legislative history relating to Sections 101 and 103 nowhere indicates that Congress disagreed with or sought to change any of the decisions under the 1909 Act relating to the protection accorded factual compilations.

B. The Definition Of Compilation In The 1976 Act Was Not Intended To Change The Copyright Principles Established For Compilations Under The 1909 Act

Although Congress included the "selected, coordinated, or arranged" language in the definition of compilation contained in the 1976 Act, that decision was not made, as Petitioner and *Amici* suggest, because Congress intended that such selection, coordination or arrangement would be the only protectible elements of a compilation. Instead, the reference to "selected, coordinated, or arranged" was included simply to make it clear that *all types* of works made up of collected and assembled preexisting data were to be classified as compilations if they met the established standard of originality. This interpretation is consistent with the language of the *House Report* which states:

Between them the terms "compilations" and "derivative works" which are defined in section 101, comprehend every copyrightable work that employs preexisting material or data of any kind.

House Report at 57. Thus, Congress was not seeking to add new elements of originality which applied only to compilations. It was simply stating that *all types* of collections of preexisting material (however organized) fall within the definition of "compilation" if the work as a whole constitutes "an original work of authorship."

Under this interpretation, it is clear that the process and effort necessarily involved in collecting and assembling factual material constitute the "selection, coordination or arrangement" referenced in the definition.⁸ Whether such a work is a copyrightable "compilation" depends upon, as the definition clearly states, whether "the resulting work as a whole constitutes an original work of authorship." 17

⁸Professor Beryl R. Jones persuasively suggests that the word "coordination" in the definition easily encompasses the act of "taking facts which exist in a multitude of places and in a variety of forms and putting them in a single location." Jones, *Factual Compilations and the Second Circuit*, 52 Brooklyn L. Rev. 679, 701 (1986).

U.S.C. § 101 (emphasis added). Congress' explanation in the *House Report* that "[a] compilation results from a process of selecting, bringing together, organizing, and arranging previously existing material of all kinds, regardless of whether the individual items in the material have been or ever could have been subject to copyright" is in accord with this interpretation. *House Report* at 57.

If a compilation meets the "original work of authorship" test, then *all* elements reflecting such original authorship of the compiler, including the collection and assemblage of data created by the author and the presentation and arrangement of such data, are protected under familiar copyright principles. The collection and assemblage of data as a whole is the *expression* of the author of a factual compilation—it is that aspect of the work which "display[s] the stamp of the author's originality." *Harper & Row, Publishers, Inc. v. Nation Enterprises*, 471 U.S. 539, 547, 105 S. Ct. 2218, 2224 (1985). Of all of the immense mass of factual data available in the world, a compiler determines a topic for which he or she believes it will be valuable (and profitable) to collect and assemble data. The compiler may decide to create a comprehensive collection of available data on a particular topic, or may conclude that only some types of data pertaining to a topic should be included in the compilation. The important point is that the resulting collection and assemblage is the original expression of the compiler's authorship as long as the collection as a whole was independently created and not copied from a prior compilation.

The fact that the collection and assemblage of data as a whole is protected expression does not mean that the preexisting data contained in the compilation are protected. As provided in Section 103(b) of the 1976 Act, "[t]he copyright in a compilation . . . does not imply any exclusive right in the preexisting material." 17 U.S.C. § 103(b). The preexisting data continue to be as freely available from the same source for use by subsequent compilers as they were for use by the initial compiler. It is the collection and assemblage, or compilation, of the data *as a whole* that is

protected, not the underlying data. Such protection does not stifle creativity in the preparation of subsequent compilations, or unduly restrict subsequent compilers, because "only copying sufficient to produce a substantially similar collection would generate potential liability." Denicola, *Copyright in Collections of Facts: A Theory for the Protection of Nonfiction Literary Works*, 81 Colum. L. Rev. 516, 531 (1981) ("Denicola"). In addition, the fair use doctrine is available to help determine the permissibility of particular uses of the collection and assemblage of data contained in a compilation. 17 U.S.C. § 107.

The construction of the statutory definition of a "compilation" urged by Petitioner and *Amici* would accord no protection to a compilation other than to the compiler's original selection, coordination or arrangement of the data contained in the compilation. See, e.g., Petitioner's Brief at 13, 18; Brief of *Amicus Curiae* Direct Marketing Association at 8-9. Thus, under Petitioner's and *Amici*'s view, if a compiler collects, assembles and alphabetically arranges the names of *all* of the military battles that occurred in recorded time, that compilation may be freely copied, even by a direct competitor, because no selection was exercised (the list is comprehensive) and an alphabetical arrangement obviously is not original. On the other hand, if the compiler publishes an alphabetical list of those battles he or she deems "most decisive" in world history, then Petitioner and *Amici* apparently would accord protection to that list because the author exercised "selection" (i.e., exclusion) in compiling the information. This interpretation would lead to the perverse result that the more comprehensive the collection of data in a work, and the more accessible and familiar the presentation of such data, the less likely the work would be considered a protectible compilation. This would be a nonsensical result, and certainly is not the result intended by Congress when it enacted the definition of

"compilation" contained in the 1976 Act.⁹

Congress did not intend that the language it chose relating to preexisting data being "selected, coordinated, or arranged" would operate to *exclude* particular collections and assemblages of preexisting material from the definition of "compilation," and hence from the protection of copyright. Instead, it relied upon the language in the definition that "the resulting work as a whole constitutes an original work of authorship," together with the established originality standard of the 1909 Act, to perform that exclusionary function. Congress intended the "selected, coordinated, or arranged" language to perform an *inclusionary* role, and the legislative history demonstrates this intent.

IV. PETITIONER'S USE OF RESPONDENT'S TELEPHONE DIRECTORY IN THIS CASE IS NOT PERMITTED BY SECTION 103 OF THE 1976 ACT

Contrary to Petitioner's and *Amici*'s assertions, Section 103 of the 1976 Act does not sanction substantial copying of the factual material contained in a copyrighted compilation. Section 103(b) provides in part that:

The copyright in a compilation or derivative work extends only to the material contributed by the author of such work, as distinguished from the preexisting material employed in the work, and does not imply any

⁹As a further example, consider the plight of computer databases under the interpretation urged by Petitioner and *Amici*. Most databases are considered to have greater utility and value the greater their comprehensiveness (i.e., *all* information and material relevant to the topic of the database are sought out by the compiler). Similarly, the arrangement of data in a database is often a function of the technicalities of electronic memory. Thus, unless the information may be retrieved only in a way which represents a particular arrangement of the data intended by the compiler, it is often meaningless to speak of a particular "arrangement" of the data in the database. See *Denicola* at 531. Without any demonstrable arrangement on the part of database compilers, such databases could be freely copied by anyone under Petitioner's and *Amici*'s interpretation of the statutory definition.

exclusive right in the preexisting material.

17 U.S.C. § 103(b). From this language, Petitioner and *Amici* argue that the names, addresses and telephone numbers contained in a white pages directory are "preexisting materials," that the compiler of such a directory has performed no selection or arrangement of data which would result in authorship, and that, as a result, substantial if not wholesale copying of such names, addresses and telephone numbers is permissible. See, e.g., Petitioner's Brief at 21-22; NADP Brief at 11-12.

This analysis assumes that there is no "material contributed by the author" of a white pages directory because such a directory contains factual, public domain material arranged alphabetically. However, this analysis ignores the fact that the "material" contributed by the author of such a directory includes the collection and assemblage (or coordination) of data *as a whole*. Just as an original selection or arrangement of public domain data may be "material contributed by the author" of a compilation (as Petitioner and *Amici* acknowledge), so too can the original collection and assembly of such data as a whole constitute "material contributed by the author," and both are protected by copyright. See discussion in Section III, *supra*.

While it was clear under the 1909 Act that copyright protection was accorded to the collection and assemblage of factual data *as a whole*, and that substantial copying of the resulting compilation of data was not permitted, it also was clear that the compiler had no exclusive right in the

preexisting factual material.¹⁰ This principle was the basis of another venerable doctrine of copyright law which Petitioner and *Amici* seek to overturn, the verification rule.

The verification rule was firmly established under the 1909 Act. Essentially, the rule holds that if a compiler first independently collects and assembles factual material to be contained in a new compilation, he or she then may compare and check the new compilation with an existing copyrighted compilation and publish the result after verifying any additional items derived from the existing compilation. However, the verification rule does not permit a compiler to substantially copy an existing work for use in a subsequent compilation, even if the compiler later verifies the material copied by checking the original sources. *Illinois Bell Tel. Co. v. Haines & Co.*, 905 F.2d 1081, 1086 (7th Cir. 1990); *G.R. Leonard & Co. v. Stack*, 386 F.2d 38, 39 (7th Cir. 1967); *W.H. Anderson Co. v. Baldwin Law Publishing Co.*, 27 F.2d 82, 89 (6th Cir. 1928); *Jeweler's Circular Publishing Co. v. Keystone Publishing Co.*, 281 F. 83, 91-92 (2d Cir.), cert. denied, 259 U.S. 581 (1922); *Sampson &*

Murdock Co. v. Seaver-Radford Co., 140 F. 539, 544-45 (1st Cir. 1905).¹¹

In addition to defining the scope of protection accorded to factual information contained in compilations, the verification rule was also an early application of the doctrine of fair use. Courts adopting the rule essentially used it to delineate the boundaries of permissible use of existing compilations by subsequent compilers of competing works. See e.g., *G.R. Leonard & Co.*, 386 F.2d at 39 ("[i]t is recognized that a compiler of a directory or the like may make a fair use of an existing compilation serving the same purpose if he first makes an honest, independent canvass"); *W.H. Anderson Co.*, 27 F.2d at 89 ("there is the public interest in having subsequent workers in a field allowed to make use of the accumulated knowledge of the past, especially knowledge of the sources"); *Jeweler's Circular*, 281 F. at 91.

While *Amici* scorn the verification rule, see NADP Brief at 23-24, it has been, as an application of the fair use doctrine, a settled principle of copyright law for nearly 100 years. In enacting the 1976 Act, the doctrine of fair use as developed by courts under the 1909 Act was yet another area of copyright law which Congress expressly intended to remain unchanged:

The bill endorses the purpose and general scope of the judicial doctrine of fair use, but there is no disposition to freeze the doctrine in the statute,

¹⁰Section 7 of the 1909 Act provided in relevant part that:

Compilations or abridgments, adaptations, arrangements, dramatizations, translations, or other versions of works in the public domain . . . or works republished with new matter, shall be regarded as new works subject to copyright under the provisions of this title; but the publication of any such new works shall not affect the force or validity of any subsisting copyright upon the matter employed or any part thereof, or be construed to imply an exclusive right to such use of the original works, or to secure or extend copyright in such original works.

Copyright Act of 1909, ch. 391, § 7, 61 Stat. 655 (recodified 1947).

¹¹Petitioner repeatedly asserts that copying Respondent's compilation was its "only . . . feasible alternative" because of the "practical unavailability" of the data contained therein. See Petitioner's Brief at 9, 23. It is, of course, always the case that copying the expression in a copyrighted work is easier and cheaper than creating one's own expression. However, to the extent that there exists special difficulty in collecting the factual data involved in this case, it must be remembered that the factual material found in many other types of compilations is readily available from other sources. For example, government data and various forms of financial data which are frequently compiled are readily available to subsequent compilers from the original sources. See also discussion regarding antitrust law mandates in Section I, *supra*.

especially during a period of rapid technological change. . . . Section 107 is intended to restate the present judicial doctrine of fair use, not to change, narrow, or enlarge it in any way.

House Report at 66 (emphasis added). Thus, Congress neither repudiated the verification rule as an application of the fair use doctrine when it enacted the 1976 Act, nor indicated that Section 103(b) was meant to effectuate a sweeping change from the 1909 Act in the scope of protection accorded to compilations of factual material.¹²

CONCLUSION

Petitioner and *Amici* seek to have this Court lay aside longstanding judicial authority relating to the copyright protection accorded factual compilations. Their basis for this request is a misreading of both the language and legislative history of Sections 101 and 103. Congress did not intend to work such a radical or wholesale change in established copyright law relating to compilations when it enacted the 1976 Act. The decision of the Tenth Circuit should be affirmed because it was based on a proper reading of the relevant provisions of the 1976 Act and is uniformly supported by prior precedent.

¹²The *House Report* does state that Section 103(b) is "intended to define, more sharply and clearly than does section 7 of the present law, the important interrelationship and correlation between protection of preexisting and of 'new' material in a particular work." *House Report* at 57. It is plain that Petitioner's and *Amici*'s suggested interpretation of Section 103(b) in this case—that it permits wholesale copying of the body of factual material contained in a white pages directory because it is unprotectible "preexisting material"—would do more than "define more sharply and clearly" the relationship between protection of preexisting and new material. Such an interpretation would overturn decades of judicial decisions relating to the scope of protection granted compilations and the permissible uses of data contained in such compilations. Congress did not intend Section 103(b) to produce such a result.

Respectfully submitted,

Vance K. Opperman
Counsel of Record
OPPERMAN HEINS &
PAQUIN
2200 Washington Square
100 Washington Avenue South
Minneapolis, Minnesota 55401
(612) 339-6900

Of Counsel
James E. Schatz
Bradley W. Anderson
OPPERMAN HEINS &
PAQUIN
2200 Washington Square
100 Washington Avenue South
Minneapolis, Minnesota 55401
(612) 339-6900

*Counsel for West Publishing
Company*